

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Merwin H. Alferness et al.
Serial No. : 10/667,029
Filed : September 18, 2003
For : METHODS AND APPARATUS FOR ALLOCATING
BANDWIDTH FOR A NETWORK PROCESSOR
Examiner : Tanh Q. Nguyen
Group Art Unit : 2182

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully Submitted,

Dated: February 20, 2009



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ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Final Office Action (dated October 20, 2008), claims 1-7, 11, 12-18, 22, and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,098,123 to Olnowich [hereinafter *Olnowich*]. Claims 8-10 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Olnowich*. The rejection of claims 1, 12, and 23 is illustrative as to how the rejection is clearly not proper and is without basis.

A. THE REJECTION UNDER 35 U.S.C. § 102 IS CLEARLY NOT PROPER AND IS WITHOUT BASIS AS THE REJECTION EFFECTIVELY IGNORES THE EXPRESS CLAIM LANGUAGE "A PLURALITY OF DATA TYPES"

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP* § 2131, (8th Ed. 2001) (Rev. 7, July 2008) (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Further, "[t]he elements must be arranged as required by the claim..." *Id.* (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Independent claim 1 recites, inter alia
determining an amount of memory bandwidth of
a network processor used by a plurality of
data types to transmit data through a
plurality of active ports.

Independent claims 12 and 23, which each have their own scope, recite similar features.

Applicant respectfully submits that the rejection is clearly not proper and is without basis. Specifically, it is submitted that the cited passages of *Olnowich* fail to disclose at

least the above features for at least the reasons set forth herein. Accordingly, Applicant respectfully submits that a prima facie case of anticipation has not been established.

The cited passages of *Olnowich* (col. 1, lines 30-36, FIG. 5, col. 3, lines 51-66, and cols. 3-4, lines 62-2) fail to disclose a plurality of data types. To find otherwise would be to completely remove any meaning whatsoever from the express claim term "types".

The Office Action points to four (4) ports discussed in the cited passages of *Olnowich* for disclosing four different types of data. Specifically, the Office Action contends:

port A and port B are used to transmit data
to and from processor 4; port C and port D
are used to transmit data to and from network
2 - hence four different data types through
ports A, B, C, D (col. 1, lines 30-36; FIG.
5)

Additionally, the Advisory Action points to data being slowed from one speed to another speed. However, neither the function of a port (send/receive), the destination of its data (processor/network), nor the slowing of the transmission speed of data equate to "a plurality of data types." That is, these passages have not been shown to disclose anything other than one type of data being transmitted using four (4) different ports.

Applicant respectfully notes that the burden is on the Office, not the Applicant, to establish a prima facie case. In this instance, the burden is on the Office to establish that ports A-D transmit more than one type of data.

Applicant respectfully submits that the rejection is clearly not proper and is without basis. Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 are respectfully requested.

B. THE CLAIM REJECTION UNDER 35 U.S.C. § 103 IS CLEARLY NOT PROPER AND IS CLEARLY WITHOUT BASIS AS NO SECONDARY CITATION IS

**OFFERED THAT WOULD REMEDY THE ABOVE DEFICIENCY OF THE REJECTION
OF THE INDEPENDENT CLAIMS**

Claims 8-10 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Olnowich*. Applicant respectfully traverses this rejection.

As discussed above, the cited passages of *Olnowich* fail to disclose all of the features recited in independent claims 1 and 12, from which claims 8-10 and 19-21 ultimately depend.

Applicant respectfully submits that the rejection is clearly not proper and is without basis. Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

C. CONCLUSION

For at least the reasons herein, Applicants respectfully submit that the rejections are clearly not proper, are without basis, and should be withdrawn. Further, Applicants respectfully request that the Office issue a finding that the application is allowed on the existing claims and that prosecution remains closed.

Respectfully Submitted,

Dated: February 20, 2009



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